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09/182,033 10/29/98 BURNS

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022208 LMC1/1012
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EXAMINER

KAZIMI, H

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

10/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/182,033

Applicant(s)

Burns

Examiner

Hani Kazimi

Group Art Unit

2164



☒ Responsive to communication(s) filed on Jul 26, 2000.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 30-39 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 30-39 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This communication is in response to the amendment filed on July 26, 2000. The rejections cited are as stated below:

Status of Claims

2. Of the original claims 1-22, claims 1, 2, 4, 5, 8, 9, 11, 12, 14, and 21 have been amended, and claims 23-29 have been added in the preliminary amendment filed on September 29, 1999. In the amendment filed on February 3, 2000, claims 1, 2, 4-9, 11-14, 18, 19, 21-24, and 29 have been amended. In the amendment filed on July 26, 2000, claims 1-29 have been canceled, and claims 30-39 have been added. Therefore, claims 30-39 are under prosecution in this application.

Summary of this Office Action

3. Applicants' arguments filed on July 26, 2000 have been fully considered, and discussed in the next section below or within the following rejection are not deemed to be persuasive. Therefore, claims 30-39 are rejected as being unpatentable over the art cited below, and Applicants' request for allowance is respectfully denied.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 32, 35, 38, and 39 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claim 32, the phrase "may be" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 35, 38, and 39, the limitations "-- a consumer's consumer account --" renders the claims indefinite because, it is unclear what is applied by having a consumer's consumer account. Also, claims 35, and 38, recites the limitation "-- said consumer's consumer identification means -". There is insufficient antecedent basis for this limitations in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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7. Claims 30, 32-35, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by De Lapa et al. (U.S. Patent No. 5,822,735) hereinafter "De Lapa".

Claim 30, De Lapa teaches an electronic coupon processing system (abstract) comprising:
a plurality of consumer identification means (column 3, lines 8-64, and column 9, line 58 thru column 10, line 7);

a plurality of consumer accounts associated with said plurality of consumer identification means (column 5, line 45 thru column 6, line 19);

a database for storing information for each of said plurality of consumer accounts (column 5, line 45 thru column 6, line 19);

at least one means for each of said plurality of consumers to enter unutilized coupon information from printed coupons in their possession into their consumer account based on input of their consumer identification means (column 9, line 32 thru column 10, line 30);

at least one checkout register capable of collecting specific consumer purchase information, said register additionally being connected to said database (column 16, line 61 thru column 19, line 31);

means for reconciling the unutilized coupon information in said consumer account of said specific consumer with the specific consumer purchase information based on input of said consumer identification means of said specific consumer (column 7, lines 14-40, and column 9, lines 33-57); and

means for updating a consumer account of said specific consumer to reflect utilization of

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coupons, wherein said at least one means for each of said plurality of consumers to enter unutilized coupon information from printed coupons in their possession into their consumer account is the only means provided for consumers to add unutilized coupon information into their consumer account (column 9, line 32 thru column 12, line 34).

Claim 32, De Lapa teaches that additional unutilized coupon information are added to a consumer account by the system based on market information collected for a consumer associated with said consumer account (column 4, line 22 thru column 5, line 4).

Claim 33, De Lapa teaches that said database is connected to registers at a particular store or group of stores (column 7, lines 14-40).

Claim 34, De Lapa teaches that said at least one means for each of said plurality of consumers to enter unutilized coupon information from printed coupons in their possession consists of a scanner (column 9, line 32 thru column 10, line 30).

Claim 35, De Lapa teaches that said scanner is located in a store and said store further includes means for viewing and a printer for providing a printout of unutilized coupon information in a consumer's account based on input of a consumer's consumer identification means (column 6, line 62 thru column 8, line 19).

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Claim 37, De Lapa teaches that said means for reconciling automatically sends both purchase information and coupon information directly to a clearinghouse or a manufacturer for reimbursement (column 3, lines 41-63, and column).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 31, 36, 38, and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over De Lapa et al. (U.S. Patent No. 5,822,735) hereinafter "De Lapa".

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Claim 31, De Lapa fails to teach the use of a consumer's frequent shopper card as a consumer identification means.

Official Notice is taken that frequent shopper cards are old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of De Lapa to include the use of frequent shopper cards as a consumer identification means, because it provides a system that is user friendly by scanning the frequent shopper card which can be used in order to target coupons to particular consumers.

Claim 36, De Lapa fails to teach that the printout includes an aisle location for products associated with said coupon information in said consumer account.

Official Notice is taken that printing an aisle location on a coupon is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of De Lapa to include an aisle location for products associated with said coupon information in said consumer account, because it greatly improves the efficiency of the system by providing the consumer with a coupon that contains the product location in the store.

Claim 38, De Lapa fails to teach the use of Internet to review unutilized coupon information in a consumer's account based on input of a consumer's consumer identification

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means.

Official Notice is taken that reviewing coupons through the Internet is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of De Lapa to include the use of Internet to review unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means, because it provides convenience to the user by allowing the user to access various supermarket CDR units, and review, select, and retrieve coupon information directly from the operations center.

Claim 39, De Lapa teaches the means to provide a printout of unutilized coupon information in a consumer's account (column 6, line 62 thru column 8, line 19).

Response to Arguments

11. Applicant's arguments with respect to claims 30-39 have been considered but are moot in view of the new ground(s) of rejection. The response to Applicant's arguments with respect to the claims is mentioned within the 35 U.S.C. § 102 and 35 U.S.C. § 103 rejections of this office action.

Conclusion

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann, can be reached at (703) 308-7791.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hani Kazimi

October 7, 2000



ERIC W. STAMBER
PRIMARY EXAMINER